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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,891	05/18/2006	Dominique Jean-Pierre Mabire	PRD-2120USPCT	8597

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EXAMINER	
MCDOWELL, BRIAN E	
ART UNIT	PAPER NUMBER
4161	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,891	MABIRE ET AL.	
	Examiner	Art Unit	
	BRIAN MCDOWELL	4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *20 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,9,11-16* is/are pending in the application.

4a) Of the above claim(s) *5,9,11,12 and 14-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7,13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/1/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 6/20/2008 is acknowledged. Claims 5, 9,11,12 and 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely **traversed** the restriction (election) requirement in the reply filed on 6/20/2008. The traversal is on the ground(s) that the compound and method groups are considered a unitary invention. This is not found persuasive because the inventions were shown to lack a special technical feature. Document EP 0371564 (supplied in the ISR, see page 2, line 15 and claim 10, page 93) described several compounds and methods for using said compounds that read on claim 9. Therefore, the compounds and methods are not novel and the invention lacks a special technical feature. The requirement is still deemed proper and is therefore made FINAL.

However, the election of species requirement is removed.

This application contains nonelected subject material within claims drawn to an invention elected **with** traverse in the paper of **6/20/2008**. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

An action on the merits of claims 1-4, 7 and 13 is contained herein.

Claim Objections

Claim 4 is objected to for the following informalities: the character ":_-." should be removed after the phrase “compound No. 145”.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 6 of copending Application No. 10/596086. Although the conflicting claims are not identical,

the compounds within the instant application fall directly within or closely within the scope of those in application '596086 which would render them obvious.

Both claims 1-4, 7, 13 in the instant application and claims 1, 2, and 6 in '596086 refer to 2-quinolinones and 2-quinoxalinones of the general formula I and/or simple compositions containing said compounds.

The difference from the instant claims and the claims in '596086 in regards to the general formula I is how variable R^4 is defined. In the instant application, R^4 is confined to a substituted aryl group. However, it is stated that R^4 may be a substituted aryl group in '596086, thus anticipating the compounds in the instant application obvious.

Additionally, another difference from the instant claims and the claims in '596086 is how R^3 is defined. In the instant application, R^3 is $-(CH_2)t-Z$, while in '596086 R^3 is Z. However, the compounds are obvious variants since MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH2- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, applicant recites the following: "a compound according to claim 1 wherein n is 0; X is CH". There is no antecedent basis for this claim since claim 1 has the proviso when n is 0, X has to be N.

Thus, claim 3 is rejected for indefiniteness by USC § 112, 2nd paragraph for failing to clearly point out the claim limitations.

Claim Rejections - 35 USC § 103

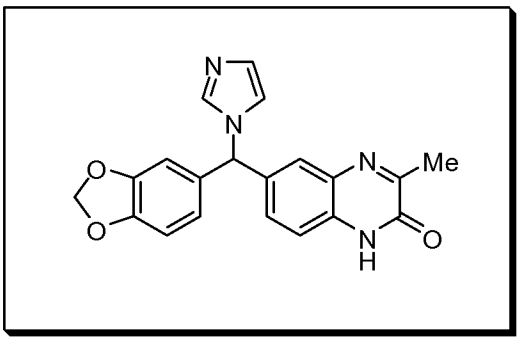
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pailer *et al*. (Monatshefte fuer Chemie) in view of Ladouceur *et al*. (WO/043950).

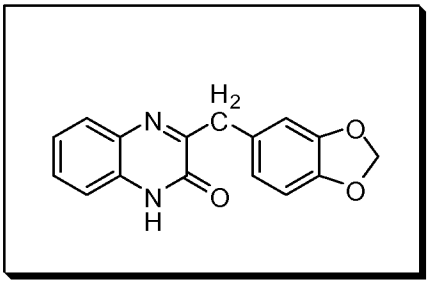
Instant claims 1-2 and 7 recite compounds of formula I.

Claims 1-2 and 7 in the instant Application may teach a compound of formula (I) or compositions containing said compound with the structure below:



wherein R_1 = methyl, n = 0, X = N, R^2 = H, R^3 = imidazoyl, and R^4 = H, R^5 and R^6 = -O-CH_2-O.

Pailer *et al*. teaches a compound with the following structure:



wherein R_1 = a benzyl group, n = 0, and X = N.

(see page 1012, compound IV).

The difference between the claimed invention and the Pailer *et al*. reference are variables R^1 and the -CH group possessing the aryl and imidazole rings on the bicyclic system.

However, substituent R^1 in the compound above could readily be moved to another site on the molecule to give a positional isomer that would be equivalent to the instant compound. MPEP 2144.09 states “Compounds which are position isomers

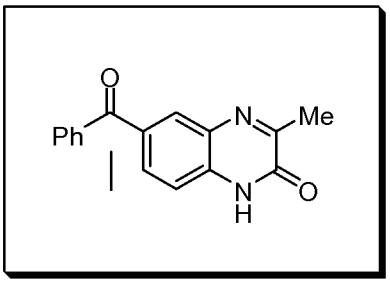
(compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH2- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

Additionally, WO/043950 document teaches similar compounds that possess various 5-membered heterocycles that would provide motivation to introduce these rings on the molecule (see table on page 87 of document).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ali *et al*. (Molecules).

Instant claim 13 recites compositions containing compounds of formula I.

Ali *et al*. teach the following compound below:



wherein R_1 = methyl, n = 0, X = N, R^2 = R^3 = C(O), and R^4 = R^5 = R^6 = H (see page 866, Scheme 2). The compound being claimed for use in this composition is anticipated by the above specie because it falls within the scope of formula I. Since the compound is anticipated, the composition would be considered obvious and is rejected under 35 U.S.C. 103(a).

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this a Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patrick J. Nolan/

Supervisory Patent Examiner, Art Unit 4161